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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,066	08/02/2001	Thomas H. Foster	PRC-4	7986

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT PAPER NUMBER

3762

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,066

Applicant(s)

FOSTER ET AL.

Examiner

George R Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the claim is incomplete for omitting essential structural cooperative relationship between elements amounting to a gap in the structure. The claim is just a listing of parts with no structural relationship between parts. The means for receiving pulsed radio frequency fields, means for transmitting, the parallel resonant circuit, and means for connecting the device to a heart are not connected directly or indirectly with each other. It can not be determined what the applicant is claiming. In addition, the “means for connecting said cardiac assist device to a heart” and “means for furnishing electrical impulses from said cardiac assist device to said heart” seem to be the same element, an electrode. Also, “induced by said pulsed radio frequency fields” is inferentially including the pulsed radio frequency fields. The RF fields have not been positively recited and have only been functionally recited (“means for receiving pulsed radio frequency fields”) and it is unclear if the applicant is claiming a means for generating the RF fields.

In claim 2, “optical means” is vague since there is no function after the means (“optical means for...”) and it is unclear if the applicant is trying to use 112 sixth paragraph.

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In claim 6, "is activated by light from a light source" is inferentially including the light source. The light source has not been positively recited and it is unclear if applicant is positively claiming the light source.

In claims 7 and 9, "is disposed within a biological organism" is vague since it sounds as if the applicant is positively claiming a connection to the body. System claims can not claim connection to the body. It is suggested to use "is adapted to be disposed..."

In claims 8-10, the claims are vague and do not limit the parent claim since the light source has not been positively recited.

In claim 12, the claim is vague and not limiting the parent claim since the RF fields have not been positively recited. In addition, "a magnetic resonance imager" is inferentially included.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindegren et al (5454837) in view of Baumann et al (5279292).

Lindgren discloses the claimed invention (with the means for protecting the heart from RF fields being the optical conductors in Baumann) except for the means for receiving pulsed RF fields, a parallel resonant frequency circuit, and means for activating said circuit. Baumann teaches that it is known to have means for receiving pulsed RF fields and a parallel resonant frequency circuit (both being the parallel resonant circuit in Baumann) and means for activating said circuit (the external resonant circuit in Baumann) to transfer energy to the implanted device to charge the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implantable device as taught by Lindgren, with the means for receiving pulsed RF fields and a parallel resonant frequency circuit and means for activating said as taught by Baumann, since such a modification would provide an IMD with means for receiving pulsed RF fields and a parallel resonant frequency circuit and means for activating said circuit to transfer energy to the implanted device to charge the device.

Conclusion

The claims contain numerous 112 second paragraph rejections making the claims scope unclear. Upon correction of the 112 second rejections, the claims may further be rejected under 35 USC 112 first and second paragraphs and/or with new art and/or art of record under 35 USC 102 and 103 and the application be made final.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612.

The examiner can normally be reached on M-F 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.


George R Evanisko
Primary Examiner
Art Unit 3762

GRE
August 11, 2003

8/11/3